

REMARKS

Claims 1-23 are pending in the current application. Applicants have amended claims 1, 2, 3, 11, and 17. Reexamination and consideration of all pending claims, as amended, are respectfully requested.

§ 103

The Office Action rejected all pending claims under 35 U.S.C. § 103(a) based on Muller, U.S. Patent 6,271,925, (“Muller”) in view of Elssner et al, DD 261422 (“Elssner”), and in certain instances in view of other references.

The Office Action takes issue with Applicants’ contention that Elssner neither discloses nor suggests inspecting both sides of a specimen:

In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e. Elssner does not show inspecting both sides of the specimen) are not recited in the rejected claim(s).

Office Action, p. 5 (emphasis added).

Claim 1, prior to amendment, recited “[a] system for scanning both sides of a two sided specimen...” Claim 11 recited “[a] method for inspecting both sides of a dual sided specimen simultaneously...” Claim 17 recited “[a]n apparatus for inspecting both sides of a two sided specimen...” While Applicants are mindful of the law relating to preambles and interpretation thereof, Applicants nonetheless contend it is simply incorrect to state that inspecting both sides of a specimen, recognized as absent from Elssner, is “not recited in the cited claims.” The requirement of inspecting both sides of a two sided specimen have always been recited in the independent claims.

Applicants have nonetheless emphasized the dual channel/dual reflective surface and dual sided inspection aspect of the design by amending independent claims 1, 11, and 17 to emphasize these aspects of the design.

With respect to claim 1, any purported combination of Muller and Elssner does not show, *inter alia*, “a plurality of reflective surfaces for receiving light energy from said diffraction grating.” With respect to claim 11, “directing said diffracted light energy toward both sides of said specimen and toward a plurality of reflective surfaces each mounted substantially parallel to said specimen” is absent from the suggested combination. With respect to claim 17, missing from the purported combination of Muller and Elssner is, *inter alia*, “a plurality of reflecting surfaces, each reflecting surface mounted substantially parallel to said specimen and receiving nonzero order energy from said light energy splitting device.” Applicants therefore respectfully submit that the amended independent claims include elements not shown in the cited references.

This dual channel/dual reflective surface/dual sided inspection design is entirely missing from Elssner as recognized in the Office Action. Reflective surfaces are altogether absent from Muller. The absence of these claim limitations from the cited references render independent claims 1, 11, and 17 allowable, as these claims include express limitations entirely missing from the cited references. Neither Muller nor Elssner disclose nor suggest a plurality of reflective surfaces for inspecting both sides of a dual sided specimen as presently claimed.

The Office Action takes issue with Applicants’ discussion of the Elssner reference, the incorporation of the Elssner design elements into Muller, and characterization of Elssner design aspects not rejected in the claims. Applicants discussed elements of the Elssner reference and their inapplicability to Muller to demonstrate that one of ordinary skill in the art could not simply employ the Elssner device in the Muller design and produce an operable or useful design, or in other words, the combination of Muller and Elssner would not work in the manner alleged. Applicants stand by this contention, and maintain that combining Elssner with Muller in the manner suggested would not teach one of skill in the art to make and use the inspection system and method claimed, if it could operate at all. Such a design would not operate in the intended

dual sided inspection manner claimed, as the design would be unable to scan both sides of a dual sided specimen according to the limitations recited. Prior art must be enabling, i.e. it must enable one of ordinary skill in the art to make and use the apparatus or method. *See Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997) (“In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.” (quoting *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989))). Here, the teachings of Elssner, particularly when combined with Muller in the manner suggested, would not enable one of ordinary skill in the art to make or use the dual sided inspection system and apparatus claimed.

Thus while Applicants recognize that an evaluation of what the combined teachings would have suggested to those of ordinary skill in the art is needed, if the combined teachings would not enable one skilled in the art to make and use the apparatus or method, the combined teachings do not render the claimed invention obvious. Here, the combination of the Elssner design with the Muller design would not enable one skilled in the art to make or use the dual-sided inspection system and method claimed.

Applicants again contend that there appears to be no motivation to combine the Muller interferometer with the Elssner system. Muller neither discloses nor suggests a reflective surface as claimed. Elssner does not disclose or suggest inspecting both sides of a dual sided specimen, collimating light into two separate channels, receiving light energy transmitted from each channel and passing nonzero order light energy toward the specimen, or using diffraction gratings as presently claimed.

On combining Muller with Elssner, the Office Action states, apparently as a basis for combining the references, that “a reference surface for comparing the reference surface to a sample surface is knowledge generally available to one of ordinary skill in the art.” Office Action, p. 5. First, this statement does not evidence a motivation to combine, but rather a desired result (use of a reflective surface apparently in the Muller design) not present in nor suggested by the references themselves. Second, such a statement bears little or no relationship

with the claims themselves, is not pertinent to the claims, and is an apparent attempt to simply find some basis, or any basis, to combine the cited references.

The statement of the purported motivation to combine at p. 5 of the Office Action relies on alleged knowledge of one skilled in the art at the time of the invention. In accordance with 37 C.F.R. § 1.104 (d)(2) and to preserve Applicants' argument on appeal, Applicants request that the Examiner provide an affidavit that supports the rejection of the claims based on the official notice, common knowledge, or personal knowledge of the Examiner, or provide a reference demonstrating the purported common knowledge. *See In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on "common knowledge and common sense" did not fulfill the PTO's obligation to cite references to support its conclusions, as PTO must document its reasonings on the record to allow accountability and effective appellate review); *see also, In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001) ("This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. ... With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense"); Manual of Patent Examining Procedure 2144.03 ("If the applicant traverses [] an assertion [that a concept is 'well known' or 'matters of common knowledge'] the examiner should cite a reference in support of his or her position."). Applicant requests the Examiner produce a reference showing "a reference surface for comparing the reference surface to a sample surface," or an affidavit in support of the rejection.

Despite the allegation in the Office Action, it remains unclear from the actual references, or other relevant tangible evidence, how or why one would combine the references to form the design currently claimed by Applicants as alleged by the Office Action. Aspects of the Muller design, such as inspection of both sides of the specimen, could not readily be employed in Elssner. Further, it is unclear whether the holograms of Elssner could operate in any manner in the Muller design, and in particular operate with the Muller design to perform a dual sided inspection of a specimen. Applicants specifically note that the angle of emission of light from the Elssner hologram H1 drastically differs from both the light path emissions of the Muller

design and the current design, tending to teach away from use of the Elssner hologram from the Muller interferometer. In short, there is no motivation nor reason for combining the references in the manner suggested present within the references themselves, but instead all that has been presented is an improper attempt to use specific limited ideas from each reference to deprecate the claimed invention.

Applicants respectfully submit that the Examiner has used hindsight in rejecting the claims herein. It is only through hindsight, after seeing Applicants' disclosure, that it would be considered possible to create the hearing aid design as claimed by the Applicants.

With regard to the use of hindsight, or the use of an Applicant's teaching to combine references, the courts have overwhelmingly condemned such combinations and have upheld the validity of patents or claims of patents in which such hindsight was employed to combine the references. *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), (condemning the "insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"); *In re Fine*, 837 F.2d 1044, 1051 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.") Applicant respectfully submits that combination of aspects of the Muller reference with the Elssner design is merely a hindsight reconstruction of the invention using Applicants' disclosure and claims as a guide. Such hindsight reconstruction of the claimed system is inappropriate

Based on the foregoing, Applicants respectfully submit that claims 1, 11, and 17 are allowable over the references of record, and that all claims dependent from these independent claims are allowable as they depend from an allowable base claim.

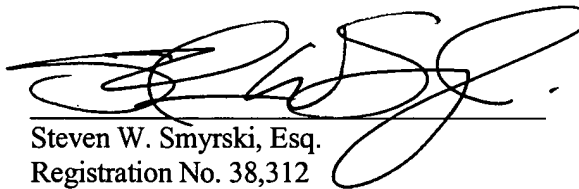
Accordingly, it is respectfully submitted that all claims fully comply with 35 U.S.C. §103.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims, as amended, are respectfully requested and allowance of all the claims at an early date is solicited.

Applicants believe that no fees are due in accordance with this Response beyond those included herewith. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account 502026.

Respectfully submitted,



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